Remarks

Claims 1, 2, 4 and 6 are pending. Claims 1, 2, 4 and 6 have been rejected. Claim 1 has been amended. Importantly, the claim amendments should not be construed to be an acquiescence to any of the claim rejections. Rather, these amendments are being made solely to expedite the prosecution of the above-identified application. The Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

Response to Claim Rejections based on 35 USC § 112 ¶ 2

Claims 1, 2, 4 and 6 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner contends that the values of variable X defined as OTf, OTs, ONf and OMs are indefinite because they are not defined.

In order to expedite the prosecution of this application, claim 1 has been amended to replace the rejected abbreviations with specific, unambiguous formula. Support for these amendments can be found in the specification, on page 26, second paragraph, first sentence, where Tf, Ts, Nf, and Ms are explicitly defined. Given the claim amendments, the Applicants respectfully request the withdrawal of the rejections of claims 1, 2, 4 and 6 based on 35 USC § 112¶2.

Request for Withdrawal of Premature Final Rejection

The Applicants respectfully request withdrawal of the Final Rejection in the outstanding Office Action. Specifically, the Applicants contend that the finality of the Office Action was inappropriate because the Examiner introduced a new grounds of rejection based on Goldschmidt et al.

In the previous Response to Office Action, the Applicants narrowed and canceled pending claims. Therefore, if the Examiner contends that Goldschmidt constitutes a *prima facie* showing of obviousness for the pending claims, the same rejection might have been advanced in the initial, non-final Office Action. In other words, the rejection was not made on the basis of a claim amendment. Moreover, Goldschmidt was not disclosed by the Applicants in an IDS

submitted in the interim. Importantly, the MPEP states "under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." MPEP § 706.07(a). The Applicants respectfully contend that this MPEP excerpt is dispositive.

Accordingly, the Applicants request withdrawal of the Final Rejection.

Response to Claim Rejections based on 35 USC § 103

Claims 1, 2, 4 and 6 are rejected as being unpatentable over Goldschmidt (*J. Am. Chem. Soc.* **1951**, *73*, 2940-2941). Specifically, the Examiner contends that this reference "discloses nine different compounds" which would render the claimed compounds obvious given that "Cl, Br, and I are all halogens and, therefore, it would have been obvious to one skilled in the art to prepare the instant compounds by substituting Cl or Br with I." The Applicants respectfully traverse.

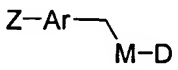
MPEP § 2144.09 discusses the patentability of structurally similar chemical compounds. Critically, when prior art compounds have no utility or only utilities unrelated to the claimed compounds, the prior art compounds, although structurally similar, are not sufficient to establish a *prima facie* showing of obviousness. *See In re Steminiski*, 444 F.2d 581, 170 USPQ 343 (CCPA 1971) (if the prior art does not teach any specific or significant utility for the disclosed compounds, then the prior art is not sufficient to render structurally similar claims *prima facie* obvious because there is no motivation for one of ordinary skill in the art to make the reference compounds, much less any structurally related compounds). Given that the cited compounds have no disclosed utility, one of ordinary skill in the art would not have been motivated to modify them to arrive at the claimed compounds.

Accordingly, the Applicants respectfully request the withdrawal of the rejections of claims 1, 2, 4 and 6 based on 35 USC § 103.

Response to Rejections Based on the Judicially-Created Doctrine of Obviousness-Type Double Patenting

Claims 1, 2, 4 and 6 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,693,178 ("the '178 patent"). The Examiner contends that although the conflicting claims are not identical, the instant compounds are encompassed by the compounds of formula **53** when M represents O. The Applicants respectfully disagree.

Claims 1-10 of the '178 patent do not encompass the instant claimed compounds. The '178 patent claims compounds represented by formula (**53**), wherein D is selected from the group consisting of allopyranoside, altropyranoside, gulopyranoside, idopyranoside, talopyranoside, arabinofuranoside and lyxofuranoside.



53

Importantly, in formula **53** even when M is oxygen, D may not be anything other than a furanoside or pyranoside. In the instant claims, the group corresponding to -M-D may only be selected from the group consisting of trifluoromethanesulfonyl, nonafluorobutanesulfonyl, *p*-toluenesulfonyl and methanesulfonyl. *None of these groups comprises a furanoside or pyranoside.* Therefore, there is no overlap between the claims of the '178 patent and the instant claims.

Accordingly, the Applicants respectfully request the withdrawal of the rejections of claims 1, 2, 4 and 6 based on the Judicially-Created Doctrine of Obviousness-Type Double Patenting.

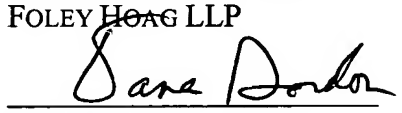
Fees

The Applicants believe there are no required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any required fee to our Deposit Account, **06-1448**.

Conclusion

In view of the above amendments and remarks, it is believed that the pending claims are in condition for allowance. If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned at (617) 832-1000.

Respectfully submitted,
FOLEY ~~HOAG~~ LLP



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